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10/634,260	08/05/2003	Frank P. Baldiga	RSW920030053US1	7052

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EXAMINER
WHIPPLE, BRIAN P

ART UNIT	PAPER NUMBER
2452	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

	Application No.	Applicant(s)
	10/634,260	BALDIGA ET AL.
Office Action Summary	Examiner	Art Unit	
	BRIAN P. WHIPPLE	2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _20 May 2009_.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,8-10 and 13-26_ is/are pending in the application.
  4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1,8-10 and 13-26_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  a)☐ All b)☐ Some * c)☐ None of:
    1.☐ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
       application from the International Bureau (PCT Rule 17.2(a)).
  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1, 8-10, and 13-26 are pending in this application and presented for

examination.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set forth

in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR

1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn

pursuant to 37 CFR 1.114. Applicant's submission filed on 5/20/09 has been entered.

Response to Arguments

3.   Applicant's arguments filed 5/20/09 have been fully considered but they are not

persuasive.

4.   As to claim 1, Applicant argues the modifying is not "based on a particular user and a

particular device" and that sections [0064] and [0065], ln. 1-7 cannot serve as the basis for

"generating a unique device identifier." The Examiner respectfully disagrees.

[0065] of Matsuda discloses the generating of a unique device identifier, as stated in

the previous Office action. Furthermore, the immediately preceding section [0064] and

section [0065] are relied upon by the Examiner to disclose the generation is done "based on a

particular user and a particular device" ([0064]; [0065], ln. 1-7; a host name is data for a

particular user and a particular device; the generating is based on the IP address request by a

particular user/device and the existing IP addresses assigned to particular users/devices).

5.   As to claim 1, Applicant argues the use of static addresses does not inherently equate

to permanently storing IP addresses. The Examiner respectfully disagrees. The use of static IP

addresses was well known in the art at the time of the invention to consist of permanently

storing IP addresses (as opposed to the dynamically stored/assigned IP addresses that result

from DHCP alone).

       Furthermore, Applicant argues the storing is not done in every respective device. The

Examiner respectfully disagrees. A device inherently is aware of its own address in a

network. Therefore, every device assigned a static address will store that address. So, by

definition, "every respective device" will permanently store its address.

       Additionally, the Examiner raises new issues related to 35 U.S.C. 112, first paragraph

and an additional piece of prior art (see the corresponding rejections below).

6.   As to claim 1, Applicant argues Matsuda fails to disclose "obtaining one of the set of

device entries based on correlation data for a particular device." The Examiner respectfully

disagrees. Matsuda discloses obtaining one of the set of device entries based on correlation

data for a particular device ([0065], ln. 7-14).

Furthermore, Matsuda discloses the associating of correlation data with each of the set

of device entries, wherein the correlation data includes a device type, user data, and device

identifier status (Fig. 7, item 720; [0064]; [0065], ln. 1-7 and 27-38; a host name is user data; it

is inherent that a device type is included in the correlation data as device type information is

embedded in the MAC address, see Poger, Col. 3, ln. 19-31 and Col. 4, ln. 48-55; whether the

IP is in use or not in use is a device identifier status).

In other words, the obtaining is done based on the MAC address, and since the MAC

address is part of the correlation, the obtaining is done based on the correlation data.

Additionally, the device type is included in the correlation data as device type information is

embedded in the MAC address.

7.   As to claim 1, Applicant argues Okano fails to disclose setting the device identifier

status to indicate that the device identifier for the device entry is pending after

communicating the device identifier ([0092]). The Examiner respectfully disagrees. Okano

discloses setting the status of a device identifier as "temporarily allocated" ([0092]). The

Examiner fails to see how a device identifier that is "temporarily allocated," pending the

acceptance or failure to accept of the address by a client, is not a pending status.

Claim Rejections - 35 USC § 112

8.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to
> which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth
> the best mode contemplated by the inventor of carrying out his invention.

9.   Claims 1, 8-10, and 13-26 are rejected under 35 U.S.C. 112, first paragraph, as failing

to comply with the enablement requirement. The claim(s) contains subject matter which was

not described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention.

        The Examiner is unclear to how the device identifiers can be permanently stored.

Even static IP addresses in the prior art are known to be volatile to hardware failure, a user

requesting a change of the address, etc. The specification provides no guidance to how the

device identifiers can be permanently stored in the infinite.

Claim Rejections - 35 USC § 101

10.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11.   Claims 14-18 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The system of the claims is described as implemented in the memory of the system (Fig. 1, items 16 and 18; [0026]). For example, the data input system (Fig. 1, item 32) and the entry update system (Fig. 1, item 34) are implemented in memory. A process implemented in memory in this manner is not a statutory embodiment of a system (e.g., hardware or a combination of hardware and software). Rather, the Applicant appears to be intending for the system claim to cover software embodiments alone, which is not statutory under 35 U.S.C. 101. Applicant's specification explicitly states that the system may be implemented in software alone ([0035], ln. 1-2). Software fails to fall into one of the four statutory classes of invention: process, machine, manufacture, or composition of matter.

Claim Rejections – 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

> person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

13.   Claims 1, 8-10, and 13-26 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Matsuda et al. (Matsuda), U.S. Publication No. 2002/0133573 A1, with Poger et al.

(Poger), U.S. Patent No. 6,772,420 B1, providing intrinsic evidence for a device type being

embedded in a MAC address, in view of Okano et al. (Okano), U.S. Publication No.

2002/0062485 A1, and further in view of Official Notice.

14.   As to claim 1, Matsuda discloses a method of managing device identifiers, the method

comprising:

        receiving a set of device entries at a server ([0064], ln. 11-16; [0065], ln. 27-38; [0066],

ln. 1-4);

        generating a unique device identifier for every device entry in the set of device

entries ([0065], ln. 27-38),

        wherein the generating is based on a particular user and a particular device ([0064];

[0065], ln. 1-7; a host name is data for a particular user and a particular device; the

generating is based on the IP address request by a particular user/device and the existing IP

addresses assigned to particular users/devices), and

        wherein the unique device identifier of every device entry is stored permanently in

every respective device corresponding to every device entry for subsequent communication

with the server ([0079]; static addresses, or static IP, inherently includes permanently storing

IP addresses);

   associating correlation data with each of the set of device entries, wherein the

correlation data includes a device type, user data, and device identifier status (Fig. 7, item

720; [0064]; [0065], ln. 1-7 and 27-38; a host name is user data; it is inherent that a device

type is included in the correlation data as device type information is embedded in the MAC

address, see Poger, Col. 3, ln. 19-31 and Col. 4, ln. 48-55; whether the IP is in use or not in

use is a device identifier status);

   obtaining one of the set of device entries based on correlation data for a particular

device ([0065], ln. 7-14),

   wherein the device identifier status for the obtained one of the set of device entries

indicates that the device identifier is unused (Fig. 7, item 720; [0065], ln. 27-38);

   receiving a request from the particular device for an assigned device identifier,

wherein the request includes correlation data for the particular device ([0065], ln. 1-14);

   communicating the device identifier for the one of the set of device entries to the

particular device ([0066], ln. 12-17); and

   setting the device identifier status to indicate that the device identifier for the device

entry is in use after receiving the acknowledgment ([0066], ln. 1-4).

Matsuda is silent on setting the status to indicate that the device identifier for the device entry is pending after communicating the device identifier; and

receiving an acknowledgment from the particular device for the communicated device identifier.

However, Okano discloses setting the device identifier status to indicate that the device identifier for the device entry is pending after communicating the device identifier ([0092]); and

receiving an acknowledgment from the particular device for the communicated device identifier ([0099]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Matsuda by indicating that a device identifier for a device entry is pending after communicating the device identifier as taught by Okano in order to temporarily allocate a device identifier that may be used by a device, but avoid permanently allocating the device identifier in case the device denies the offer of the device identifier (Okano, [0099]; [0102]) in order to avoid unnecessarily setting aside device identifiers from an available pool.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Matsuda by receiving an acknowledgement from a device for the communicated device identifier as taught by Okano in order to determine if an

offer of a temporarily allocated device identifier should be formally allocated to the device

(Okano, [0099]; [0102]) in order to avoid unnecessarily setting aside device identifiers from

an available pool.

It may be argued that not every device identifier is permanently stored in Matsuda or

Okano. However, Official Notice (see MPEP 2144.03) is taken that this was well known in

the art at the time of the invention. For example, it may be desired by each client to have the

more reliable permanent static IP address, as this ensures a single address may always be

relied upon to reach a particular client. A network comprising solely such users would

necessarily result in a network of permanently stored device identifiers for each respective

device.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Matsuda and Okano in the aforementioned manner as

was well known in the art for the aforementioned benefit(s).

15.   As to claim 8, Matsuda and Okano disclose the invention substantially as in parent

claim 1, wherein generating a new device entry based on the received correlation data for

the particular device (Matsuda: [0065], ln. 14-26; [0066], ln. 1-4).

16.   As to claim 9, Matsuda and Okano disclose the invention substantially as in parent

claim 1, wherein the user data includes a user name ([0065], ln. 1-7; a host name is a user

name).

17.   As to claims 10, 14, 17, and 19, the claims are rejected for reasons similar to claim 1

above.

18.   As to claim 13, Matsuda and Okano disclose the invention substantially as in parent

claim 10, wherein obtaining user data for a user (Matsuda: [0065], ln. 1-14); and

        generating at least one of the set of device entries using the user data for the user

before the request is received (Matsuda: [0065], ln. 1-14; previous name and address bindings

of the client exist prior to the client's attempt to retrieve configuration information from the

server).

19.   As to claim 15, Matsuda and Okano disclose the invention substantially as in parent

claim 14, wherein a data input system for obtaining correlation data for a user and generating

at least one of the set of device entries using the correlation data for the user (Matsuda:

[0065]).

20.   As to claim 16, Matsuda and Okano disclose the invention substantially as in parent

claim 14, wherein a communication system for communicating with a device (Matsuda:

[0066], ln. 12-17).

21.   As to claim 18, Matsuda and Okano disclose the invention substantially as in parent

claim 14, wherein a verification system for verifying correlation data received from a

particular device (Matsuda: [0065]).

22.   As to claim 20, Matsuda and Okano disclose the invention substantially as in parent

claim 19, wherein communicating the device identifier of one of the set of device entries to a

particular device (Matsuda: [0066], ln. 12-17).

23.   As to claim 21, Matsuda and Okano disclose the invention substantially as in parent

claim 19, wherein program code for receiving a request from the particular device, wherein

the request includes correlation data for the particular device (Matsuda: [0065], ln. 1-14);

        program code for verifying the correlation data for the particular device (Matsuda:

[0065]); and

program code for identifying one of the set of device entries by comparing the

correlation data in the request to the correlation data in the set of device entries (Matsuda:

[0065], ln. 1-14).

24.   As to claim 22, the claim is rejected for reasons similar to claim 13 above.

25.   As to claim 23, Matsuda and Okano disclose the invention substantially as in parent

claim 1 above, wherein the generating of a unique device identifier is automatically

performed by the server or a unique device identifier is manually selected (Matsuda: [0065]).

26.   As to claims 24-26, the claims are rejected for reasons similar to claim 23 above.

Conclusion

27.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. See the Notice of References Cited (PTO-892).

28.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to BRIAN P. WHIPPLE whose telephone number is (571)270-

1244. The examiner can normally be reached on Mon-Fri (9:30 AM to 6:00 PM EST).

   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

   Information regarding the status of an application may be obtained from the Patent

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571-272-1000.

Brian P. Whipple
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Examiner, Art Unit 2452
6/5/09

/Dohm Chankong/
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